

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

The Examiner is thanked for indicating that the drawings are acceptable and that the priority documents have been received and recorded.

I. STATUS OF CLAIMS AND FORMAL MATTERS

The amendment to the specification removes the referrals to claims in the Summary of the Invention.

No new matter is added.

Claims 1-11 are currently under consideration. Claim 1 is amended without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicant is entitled.

Support for amended claim 1 can be found throughout the specification and claims as originally filed, for example, on page 4, lines 12-34, page 5, lines 1-23, and in Figures 1-3.

II. REJECTION UNDER 35 U.S.C. § 101 IS OVERCOME

Claims 7, 9, and 11 were rejected under 35 U.S.C. § 101 as allegedly disclosing an invention that is inoperative and therefore lacks utility. The Office Action contends that the rotation of the tool as disclosed would also rotate the tool at the bend, which would cause the bent portion of the tool to crimp or break, or create such forces as to render the pivot elements inoperable. This rejection is respectfully traversed.

In response, Applicants respectfully argue the inventions disclosed in claims 7, 9, and 11 are not inoperable. Firstly, claim 9 relates to the device of claim 1, wherein “the tool (12; 26) is connected to the ring (29) by a pivot connection.” This type of connection would not in itself render the invention inoperable, as it only concerns the relationship between the tool and the ring. As such, the invention of claim 9 is not inoperable.

In addition, Applicants assert that the inventions of claims 7 and 11 can function and operate without damage to the bent portion of the tool or to the pivot elements. Claims 1 and 8, upon which claims 7 and 11, respectively, are dependent, both relate to flexibly deformable tools. Given these characteristics, the tool can be rotated without crimping or breaking at the bend of the tool, and without damage to the pivot elements.

Therefore, the inventions of claims 7, 9, and 11 are not inoperable and, accordingly, reconsideration and withdrawal of the rejection under § 101 is respectfully requested.

III. THE REJECTION UNDER 35 U.S.C. § 112, 1ST PARAGRAPH, IS OVERCOME

Claims 7, 9, and 11 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. According to the Office Action, the rotation of the tool as disclosed would also rotate the tool at the bend, which would cause the bent portion of the tool to crimp or break, or create such forces as to render the pivot elements inoperable. The Office Action asserts that the disclosure does not teach materials that can be used to make the tool and/or pivot elements that would not destruct in use; determination of these materials or how to rotate the tool without destroying the holder would require more than routine investigation. This rejection is respectfully traversed.

Determining whether undue experimentation is required to practice a claimed invention turns on weighing many factors summarized in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988), for example: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples of the invention; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims.

Thus, it is respectfully submitted that for a proper Section 112, first paragraph, lack of enablement analysis, an Office Action must show that the *Wands* factors are not met. Simply, it

is respectfully asserted that the lack of enablement rejection fails to provide a fact based analysis using the *Wands* factors that supports the proposition the claimed invention require undue experimentation.

The Examiner is respectfully reminded that a specification need not contain any example of the invention, as the issue is whether the disclosure enables one skilled in the art to practice the invention without undue experimentation. *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). Simply, a determination that undue experimentation is necessary to practice the invention does not necessarily follow from a lack of examples in the specification. And, the Examiner is further respectfully reminded that an applicant need not describe all actual embodiments of a claimed invention.

Applicant respectfully submit that one skilled in the art would not be subjected to undue experimentation in order to make/use the invention disclosed in claims 7, 9, and 11. As noted above, claim 9 relates to the connection between the tool and the ring, which is described in the claim and in the specification (page 7, lines 4-7) as a pivot connection. Such connections are well known in the art and knowledge of this connection is within the skill of those in the art. The Office Action questions the material used for the tool, but the connection between the tool and the ring can be a pivot connection regardless of the material of the tool. Thus, one skilled in the art can make/use claim 9 without undue experimentation.

Further, a skilled artisan would also be enabled to make/use the inventions of claims 7 and 9. The claims (claims 1 and 8) and specification (page 4, lines 12-34; page 6, lines 16-33) clearly indicate that the tool can be flexibly deformable or flexibly deformable elastically. Moreover, materials used in dentistry for similar applications are well known in the art (see U.S. Patent Nos. 4,512,769 and 6,162,202). In using such materials that are flexibly deformable, the tool of the present invention can be rotated without fatiguing/breaking at the bend, and without causing damage to the pivot elements.

Thus, one skilled in the art would not be subjected to undue experimentation in order to make/use the inventions disclosed in claims 7, 9, or 11. Accordingly, reconsideration and withdrawal of the rejection under § 112, first paragraph are respectfully requested.

IV. THE REJECTION UNDER 35 U.S.C. § 112, 2ND PARAGRAPH IS OVERCOME

Claims 1-11 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action contends that the recitation of “whose generatrices” is unclear, as a generatrix is an element or line that generates a surface when it is moved, and it is unclear what is meant by “generatrices” (plural lines). The Office Action also alleges that if one line is claimed, it is unclear what is meant by a line that is always parallel to the axis of the cylindrical part. This rejection is respectfully traversed.

In response, Applicants note that claim 1 is amended herein, such that the part opening to the outside of the body is clarified to have a surface of which one of the generatrices is substantially parallel to the axis of the cylindrical part of the channel. Thus, it is clear that the invention of instant claim 1 does not refer to multiple generatrices, but only one line. Further, Applicants disagree with the Office Action’s allegation that “if one line is claimed, the line would not always be parallel to the axis of the cylindrical part.” Applicants assert that the part opening to the outside of the body widens towards the outside of the body, as recited in claim 1. Therefore, given that the surface of the part widens, there will be one generatrix of the surface that can be substantially parallel to the axis of the body.

Accordingly, reconsideration and withdrawal of the rejection under § 112, second paragraph are respectfully requested.

V. THE REJECTIONS UNDER 35 U.S.C. § 103(a) ARE OVERCOME

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under §103 is whether the PTO has stated a case of *prima facie* obviousness. “The PTO has the burden under §103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P. §706.02(j):

...three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

§ 103(a) as unpatentable over Cislak

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cislak (U.S. Patent No. 1,993,398). According to the Office Action, Cislak relates to a tool holder with an elongated body, a channel, a cylindrical part of the channel and a widened part of the channel, a means for keeping a tool in position, and a generatrix of the widened channel parallel to the axis of the cylindrical part. The rejection is respectfully traversed.

In response, Applicants argue that Cislak does not teach or suggest all claim limitations of the present invention. Cislak does not teach or suggest a “means...which keep the tool...in position and are arranged in such a way that the axis of the tool...in the operating phase is not parallel to the axis of the body...” (emphasis added). Rather, Cislak relates to a means of keeping a tool in a position that is parallel to the axis of the body, as clearly shown in Figure 1. As such, Cislak does not teach or suggest all limitations of the present invention.

In addition, a skilled artisan would not successfully arrive at the claimed invention by using the teachings of Cislak. In Cislak, the means of holding the tool in position is attached directly to the body via a thread engagement as shown in Figure 2. Because of this type of engagement, it is not possible to alter the angle of the axis of the tool in Cislak such that it is not parallel to the axis of the body. The attachment of the means to the body in Cislak ensures that the axis of the tool is parallel to the axis of the body. Therefore, given the design of the Cislak device, a skilled artisan would not expect to successfully arrive at the present invention wherein the axis of the tool is not parallel to the axis of the body.

§ 103(a) as unpatentable over Cislak in view of Gibbs

Claim 11 was also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cislak in view of Gibbs (U.S. Patent No. 6,468,248). The Office Action asserts that it would

have been obvious to one skilled in the art to modify the tool holder of Cislak with a rotation means mentioned in Gibbs. The rejection is respectfully traversed.

In response, Applicants reiterate the arguments above, namely that Cislak does not teach each and every element of the claimed invention. Cislak does not teach or suggest an operating tool having an axis that is not parallel to the axis of the body in the operating phase, as disclosed in claim 1; in contrast, the device of Cislak features an operating tool having an axis that is parallel to the axis of the body. Importantly, Gibbs does not remedy this deficiency. Thus, Cislak and Gibbs, individually or together, do not teach each and every element of the claimed invention.

Further, as noted above, one skilled in the art would not successfully arrive at the present invention using the teachings of Cislak and Gibbs. Due to the direct attachment of the tool to the body in Cislak, the axis of the tool cannot be unparallel to the axis of the body. Similarly, considering the attachment of the tool to the body in Gibbs (see Figures 1, 2A, and 2B), the axis of the tool also cannot be unparallel to the axis of the body. Thus, a skilled artisan would not successfully arrive at the present invention in view of these references.

Accordingly, reconsideration and withdrawal of all rejections under § 103(a) are respectfully requested

VI. OBJECTION OF THE SPECIFICATION IS OVERCOME

The specification was objected because of references to claims, in particular in the Summary of Invention. In response, Applicants have amended the specification such that “claims” is not recited Summary of Invention. Accordingly, reconsideration and withdrawal of the objection to the specification are respectfully requested.

CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in dark ink, appearing to read 'Ronald S. Santucci', is written over a horizontal line.

Ronald S. Santucci

Reg. No. 28,988

Telephone: (212) 588-0800

Facsimile: (212) 588-0500